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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,879	08/17/2000	Toshiyuki Shibuya	A243-1	5305

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EXAMINER
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KISS, ERIC B

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/639,879

Applicant(s)

SHIBUYA, TOSHIYUKI

Examiner

Eric B. Kiss

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The reply filed 26 July 2004, correcting the deficiencies of the reply filed 19 May 2004 has been received and entered. Accordingly, the reply filed 19 May 2004 has also been entered. Claims 1-5 and 7-34 are pending.

### ***Response to Amendment***

2. Applicant's submission of a replacement drawing corrects the issue of new matter, as detailed in the previous Office action. Although Applicant's statement that no new matter was added to the amendment filed 28 August 2003 (see Applicant's remarks on p. 3, paragraphs 2-3) has been made without any readily apparent factual support, and the Examiner maintains that said amendment did contain new matter, the issue of new matter is now moot in view of the newly submitted replacement drawing.

3. Applicant's amendment to claim 34 appropriately addresses the objection to claim 34, based on an informality, as detailed in a previous Office action. Accordingly, this objection is withdrawn in view of Applicant's amendment.

***Response to Arguments***

4. Applicant's arguments with respect to claim 1-5 and 7-34 have been considered but are moot in view of the new ground(s) of rejection.

5. However, in response to the arguments in section II.C, the Examiner notes that claim 34 does not require the request for a change of programs to be made by a user, as recited in claims 1, 5, 15, 22, and 33. Further, the Examiner maintains that Cowan meets the recited limitation of the requesting being done by a terminal device as described in the cited sections (see, for example, col. 7, lines 37-50). Further, as Cowan discloses deleting a no longer necessary program (the older version; see, for example, col. 12, lines 49-52), this deleted program cannot be later loaded into execution memory, thus inherently meeting the recited claim limitation regarding not transferring the to-be-deleted program.

***Drawings***

6. The replacement drawing was received on 26 July 2004. This drawing is acceptable. However, the newly received copy of Fig. 5 is considered informal, and new formal drawings will be required when the application is in condition for allowance.

***Claim Objections***

7. Claim 2 is objected to because of the following informalities: "said" is erroneously repeated in lines 1-2. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1, 2, 4, 5, 7, 8, 10-18, 20-28, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,848,064 to Cowan and U.S. Patent No. 6,237,144 to Delo.

As per claims 1, 4, and 32, Cowan discloses a portable terminal device (mobile terminal) comprising a memory including a program storage area storing therein at least two programs (or a plurality of programs) being characterized as to-be-used or to-be-removed programs by the terminal device (see, for example, col. 1, lines 48-57; col. 7, lines 13-31; and col. 12, lines 49-59) and a program executing area (see, for example, col. 7, lines 13-19). Cowan further discloses the memory containing a management table which stores first data about whether each of said programs is used or not (see column 7, lines 37-50; and column 12, lines 49-52), and removes a non-used program from said memory (see, for example, column 12, lines 49-55). For

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example, when an upgrade is performed in fail-safe mode, the files belonging to the new version are downloaded. During this operation, both the new files (to-be-used) and the old files (to-be-deleted) are stored in the memory. Upon successful completion of the download, the old files are discarded (deleted). Cowan fails to expressly disclose the data about whether the programs are used or not being based upon a selection from a terminal device user. However, Delo teaches a memory management table (a relational database) that stores data designating said to-be-used program and said to-be-removed, wherein said data causes said to-be-removed program to be removed from said program executing area (see, for example, col. 5, lines 15-31). Delo further teaches such data resulting from a user selection (see, for example, col. 5, lines 15-31).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to modify the device and method of Cowan to include a management table responsive to user selection as taught by Delo. One would be motivated to do so to let a terminal device user have greater control over how software is installed/modified.

As per claim 2, Cowan further discloses said to-be-used program being added to said program storage area from a program-transferring device and transferred to said program executing area, in accordance with said data (see, for example, col. 7, lines 13-36 and column 13, lines 15-46). Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 5 and 14, Cowan discloses a portable terminal device (mobile terminal) comprising a program storage area storing at least one to-be-used program transferred from a base station (see, for example, Fig. 1; and col. 11, line 66, through col. 2, line 19), a program

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executing area that stores a main program and an application program (see column 7, lines 13-36) and a memory management table that stores data designating the main and application programs as to-be-used and to-be-removed and causes the to-be-removed program to be removed from the program executing area (see, for example, column 8, lines 19-32; and column 12, lines 15-28); and a signal receiving/transmitting circuit and a central processing unit (see Fig. 2). Cowan fails to expressly disclose the data about whether the programs are used or not being based upon a selection from a terminal device user. However, Delo teaches a memory management table (a relational database) that stores data designating said to-be-used program and said to-be-removed, wherein said data causes said to-be-removed program to be removed from said program executing area (see, for example, col. 5, lines 15-31). Delo further teaches such data resulting from a user selection (see, for example, col. 5, lines 15-31). Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to modify the device and method of Cowan to include a management table responsive to user selection as taught by Delo. One would be motivated to do so to let a terminal device user have greater control over how software is installed/modified.

As per claims 7 and 27 (see the rejection of parent claim 22 below), Cowan further discloses package definition files including a program ID of each program (file name), a flag indicating whether each program is used or not (a user selection); a packet number and final packet number transferred from the program-transferring device (see, for example, column 13, lines 54-65); an initial address (mobile terminal path and host path); and a program length (memory required; see Figs. 5a through 5d; column 11, lines 24-35; and column 14, line 62

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through column 15, line 9). Therefore, for reasons stated above, such claims also would have been obvious.

As per claim 8, Cowan further discloses the memory adding only a necessary program from a program-transferring device, in accordance with said data, wherein said necessary program comprises said to-be-used program (see column 13, lines 15-46). Therefore, for reasons stated above, such a claim also would have been obvious. Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 10-12, Cowan further discloses the memory comprising an EEPROM portion (see column 7, lines 15-19) and a RAM portion (see column 9, lines 12-15). Therefore, for reasons stated above, such claims also would have been obvious.

As per claim 13, the connection of a power source to the RAM in Cowan is implied as files are transferred to and stored in the RAM (see column 9, lines 12-15). Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 15 and 22, in addition to the disclosure and teachings applied above to claims 1 and 5, Cowan further discloses a base station and a program-transferring device (host; see Fig. 1). For reasons stated above, such a claim also would have been obvious.



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As per claims 16, 21, 23, 28, and 31, see the disclosure applied above to claims 2 and 4. For reasons stated above, such claims also would have been obvious.

As per claim 26, Cowan further discloses storing data about whether the main program and application program is used or not (see, for example, column 8, lines 19-32; column 12, lines 15-28; and column 14, lines 50-61). Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 17, 18, 24, and 25, Cowan uses an IP address associated with each mobile terminal to encode transmissions (see, for example, column 8, lines 25-32). Therefore, for reasons stated above, such claims also would have been obvious.

As per claims 20 and 30, Cowan further discloses the program-transferring device comprising a memory storing a program, a encoding/transferring circuit, and a controller circuit (see Fig. 3). Therefore, for reasons stated above, such claims also would have been obvious.

10. Claims 3, 9, 19, 29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cowan in view of Delo and U.S. Patent No. 5,842,216 to Anderson et al.

As per claim 3, in addition to the disclosure and teachings applied above to claim 1, Cowan further discloses a first device to carry out a program, said first device causing said memory to boot a used program to said first device with reference to said first data, if version

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information of said memory is not coincident with a check sum of said first device, and copying programs stored in said first device into said memory (see Fig. 8(b); and column 12, lines 60 through column 13 line 46; the mobile terminal, as part of a boot-up process has its stored version information compared with that stored in the host computer, and updates are performed if necessary). Cowan fails to expressly disclose the version information comprising a checksum. However, Anderson et al. teach the use of a checksum as an advantageous alternative to simple version information, for determining if a data transfer is necessary (see, for example, col. 3, lines 54-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Cowan to include the use of a checksum in place of, or in addition to, the version information for comparing software data. One would be motivated to do so to increase the reliability of such metadata.

As per claims 9, 19 and 29, see the disclosure and teaching applied above to claim 3. For reasons stated above, such claims also would have been obvious.

As per claim 33, see the disclosure and teaching applied above to claims 3 and 5. For reasons stated above, such a claim also would have been obvious.

11. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cowan in view of U.S. Patent No. 5,414,751 to Yamada.

As per claim 34, Cowan discloses storing first indicia of said existing and used programs in a table of a memory of said terminal device (see column 7, lines 37-50; and column 12, lines 49-52); requesting a change of programs by said terminal device, said change of programs including at least one of an added program and a deleted existing program (see column 7, lines 37-50; and column 12, lines 49-52); and storing said second indicia of said change of programs in said table (see column 7, lines 37-50; and column 12, lines 49-52). Cowan further discloses loading an added program into memory (see, for example, col. 12, lines 29-59); using (booting) an updated version of software while deleting (non booting) an unused, older, version of the software (see, for example, col. 12, lines 49-52). Cowan fails to expressly disclose copying existing and used programs from a program executing area to a program storage area of said terminal device prior to performing the upgrading. However, Yamada teaches copying existing and used programs from a second memory to a first memory of a terminal device and loading an added program into the first memory as part of a software upgrading process (see, for example, col. 4, lines 20-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Cowan to include such copying during upgrading as per the teachings of Yamada. One would be motivated to do so to increase the reliability of the upgrade process.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. One or around October 28, 2004, Technology Center 2100 will be relocated to Alexandria, Virginia, and Examiner Kiss's telephone number will change to (571) 272-3699. The Examiner can normally be reached on Tue. - Fri., 7:15 am - 4:45 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552. On or around October 28, 2004,

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Technology Center 2100 will be relocated to Alexandria, Virginia, and Tuan Dam's phone number will change to (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBK/~~EBK~~  
October 7, 2004

A handwritten signature in black ink, reading "Anthony Nguyen-Ba". The signature is written in a cursive, flowing style.

ANTONY NGUYEN-BA  
PRIMARY EXAMINER